

Noll	5,725,875	March 10, 1998
McAtee et al. (McAtee)	5,942,238	August 24, 1999
Kelly et al. (Kelly)	3,961,044	June 1, 1976
Guck	EP 0626167A2	April 25, 1994

The Board of Appeals and Interferences Claim Interpretation

The Board of Appeals and Interferences, hereinafter “Board” has interpreted the preamble claim language, “skin protective composition for topical use that can prevent contact and passage to the skin of toxic chemicals and irritants found in the cosmetic industry,” as a recitation of intended use and accordingly it has been given no patentable weight, noting that “the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention’s limitations, but rather merely states, for example, the purpose or intended use of the invention,” and concluding therefore “then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.”

The applicant does not agree with the Board’s conclusion. While generally the preamble does not limit the scope of a claim, the preamble may be read to shed light on the meaning of the claim and to define the invention. *De George v. Bernier*, 768 F.2d 1318, 226 USPQ 758 (Fed. Cir. 1985). In the instant case, the subject matter mentioned in the preamble does provide additional limitations of the claim. The Federal Circuit has held that “No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim...The effect preamble language should be

given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works v. Sumitomo Elec. USA Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Terms appearing in a preamble may be deemed limitations of a claim when they “give meaning to the claim and properly define the invention.”... In the instant case, review of the application as a whole reveals that the words “a skin protective composition for topical use” breathe life and meaning into the claims and hence, is a necessary limitation to them. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994).

As the prior art does not disclose all the features of the claimed “skin protective composition” as it is defined by the inventor in the specification, the preamble does not merely state a purpose or intended use but rather provides positive limitations to the invention claimed.

Guck is relied on by the Board to describe a skin protecting foam containing stearate and sorbitol (a cosmetic vehicle) and which may also include a tenside of sodium lauryl sulfate in quantities of 1 to 3 weight%. McAtee is relied on as disclosing that sodium lauryl sulfate is considered a lathering surfactant. Column 7, lines 51-56. The Board has concluded that claim 1 does not recite a specific amount of cosmetic vehicle and thus Guck would appear to disclose a protective composition within the scope of claim 1. McAtee is construed as disclosing that lowering a composition’s surface tension with a surfactant leads to better softening and breaking up of the lipid and silicone base of the skin products, to improve removing of the lipid-silicone-containing skin products from the skin. McAtee, column 1, lines 59-64.

Noll is relied on as describing a cream composition which dries to form a topical barrier on the skin, which can be readily removed with soap and water. Noll teaches that protective skin compositions may taken the form of suspensions, emulsions, lotions, ointments and aerosol gels that form a film on the skin effective as a topical barrier.

With respect to dependent claim 13, the Board has concluded that Guck taken with McAtee teach the topical skin protective composition recited in independent claim 1 with the additional limitations of claims 3 and 13 to be found in Kelly. Kelly teaches that when skin protective agents take the form of lotions and creams (as described in Noll) it is conventional to add "other known protective agents, such as fatty acids for protection against dry dust, and petroleum jelly or waxes for protection against aqueous solutions." Kelly, column 7, lines 5-26. The examples of Kelly exemplify types of waxes and skin protective ingredients which may be added to skin protective compositions. Example 3 shows that a protective lotion containing stearate may also contain glyceryl monostearate, beeswax, petrolatum and mineral oil. The Board considers that it would have been obvious to one of ordinary skill in the art to add additional skin protective components including beeswax and petrolatum (Kelly) to a skin protective composition comprising stearate (Guck) for their known protective properties.

The applicant does not quarrel with the Board on their conclusion but notes that there must be some motivation to make the combination or modification suggested by the Board as obvious. That motivation must come from the prior art itself and not from the application.

The rejection of claim 13 on the above combination of references in view of Kelly (35 U.S.C. 103(a)) as teaching to use lipids (Kelly) in the compositions of Noll. This

rejection is based on hindsight. It is noted that claim 13 of the application is directed to a listing of preferred lipids. In the absence of any teaching of the basic invention, Kelly adds nothing further to the above combination of references.

The Board has reached an improper conclusion that an invention is unpatentable because of being "obvious" by reading back into the prior art the teachings of the invention which came later.

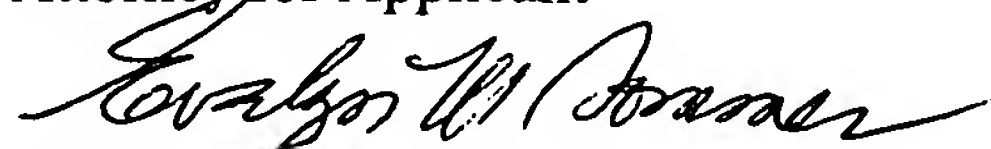
The U.S. Supreme Court has cautioned against "slipping into the use of hindsight" and urged courts "to resist the temptation to read into the prior art the teachings of the invention in issue." *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 USPQ 459, 474 (1966). For example, impermissible "hindsight" is using knowledge of the solution to determine that the answer to the technical problem was "obvious," whereas to one without knowledge of the solution, the answer was not "obvious" at all.

An example of the impermissible use of hindsight is to combine pieces of the prior art to argue that a combination invention is obvious. There must be something in the prior art that suggested the combination of these particular prior art devices and processes other than the hindsight gained from knowing that the inventor chose to combine these particular things in this particular way. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

Reconsideration of the claims and allowance of the claims are respectfully requested.

Respectfully Submitted

Attorney for Applicant



Evelyn M. Sommer

Appeal No.: 2006-1057

Registration No. 19, 603

250 Park Avenue

Suite 825

New York, NY 10177

Phone: 212-527-2657

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